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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

|                           |  |
|---------------------------|--|
| Proceeding                | 91196299   |
| Party                     | Defendant<br>Digitalmojo, Inc.   |
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| Submission                | Motion to Compel Discovery   |
| Filer's Name              | Thomas W. Cook   |
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| Signature                 | /Thomas W. Cook/   |
| Date                      | 03/12/2015   |
| Attachments               | 2015 03 12 MTC as filed.pdf(90871 bytes )  |

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

|   |   |                                     |
|---|---|-------------------------------------|
| <b>Opposition No. 91196299 (Parent)</b> | ) |                                     |
|   | ) |                                     |
| CONNECT PUBLIC RELATIONS, INC.          | ) | <b>MOTION TO COMPEL</b>             |
| Opposer,                                | ) | <b>SUPPLEMENTAL RESPONSES TO:</b>   |
|   | ) | <b>1. PETITIONER’S</b>              |
| v.                                      | ) | <b>INTERROGATORIES,</b>             |
|   | ) | <b>SET ONE AND SET TWO, AND</b>     |
|   | ) | <b>2. PETITIONER’S REQUESTS FOR</b> |
| DIGITALMOJO, INC., Applicant            | ) | <b>ADMISSIONS, SET ONE</b>          |
|   | ) | <b>AND FOR LEAVE TO SERVE</b>       |
|   | ) | <b>ADDITIONAL DISCOVERY</b>         |
| <b>Cancellation No. 92054395</b>        | ) |                                     |
| <b>Cancellation No. 92054427</b>        | ) |                                     |
|   | ) |                                     |
| DIGITALMOJO, INC.,                      | ) |                                     |
| Petitioner,                             | ) |                                     |
| v.                                      | ) |                                     |
|   | ) |                                     |
| CONNECT PUBLIC RELATIONS, INC.          | ) |                                     |
| Respondent.                             | ) |                                     |

DigitalMojo, Inc., Applicant and Petitioner in these consolidated cases (“DigitalMojo”), hereby requests leave to serve (or re-serve) on Connect Public Relations, Inc., Opposer and Respondent in these consolidated cases (“Connect”), the following discovery requests:

- a. PETITIONER’S INTERROGATORIES, SET ONE.
- b. PETITIONER’S INTERROGATORIES, SET TWO.
- c. PETITIONER’S REQUESTS FOR ADMISSIONS, SET ONE.
- d. PETITIONER’S REQUESTS FOR ADMISSIONS, SET TWO

DigitalMojo also requests the Board order Connect to provide full and complete supplemental responses to these discovery requests, as served on Connect on March 12 and March 13, 2014.

DigitalMojo further requests the Board reset the discovery and trial schedule in these consolidated proceedings as necessary to allow service of these discovery requests (if necessary) by DigitalMojo, and responses to these discovery requests by Connect.

### **FACTS AND STATUS OF CASES**

THOMAS W. COOK, counsel for DigitalMojo in these consolidated matters, hereby affirms under penalty of perjury:

#### **A. Motions Filed in This Case**

The following exposition does not recite all motions filed in these consolidated cases, but does recite relevant motions which have extended the time necessary to conduct these cases:

1. On August 22, 2011, DigitalMojo filed a Petition to Cancel the registration of the mark CONNECTPR, Reg. No. 2366850 (cancellation proceeding No. 92054395), and a Petition to Cancel the registration of the mark CONNECT PUBLIC RELATIONS, Reg. No. 2373504 (cancellation proceeding No. 91196299).
2. On August 26, 2011, DigitalMojo filed a Motion to Consolidate proceedings No. 92054395 and No. 91196299 into this opposition action.
3. Prior to filing answers to DigitalMojo's Petitions to cancel, Connect, on September 15, 2011, filed motions to dismiss the petitions to cancel as untimely compulsory counterclaims and for failure to state a claim under Fed. R. Civ. P. 12(b)(6).
4. Instead of waiting for the Board to decide its motions to dismiss, Connect, on October 25, 2011, filed a motion for partial summary judgment with regard to sixteen separate subsets of services in International Classes 35, 38, 42, and 45, and not for all of the services in those classes, based on likelihood of confusion with the CONNECT PUBLIC RELATIONS and CONNECTPR marks in its pleaded registrations. Following briefing of the motion for partial summary judgment, the Board, in a February 23, 2012 order, consolidated the above-captioned proceedings, indicating that it was treating the first motions for leave to file amended petitions to cancel as having been withdrawn, and it reset

time for remaining briefing on the amended motions for leave to file amended petitions to cancel. At the same time, the Board suspended proceedings herein “retroactive to August 26, 2011,” pending disposition of Connect's corrected motion for partial summary judgment in Opposition No. 91196299, and Digitalmojo's motions to dismiss, and the second motions for leave to file amended petitions to cancel in Cancellation Nos. 92054395 and 92054427.

5. On March 21, 2013, after further motions and responses, the Board resumed proceedings in this now consolidated action, and reset discovery and trial dates and, on August 14, 2013, after yet further motion practice, the Board resumed proceedings and reset discovery and trial dates.
6. On April 29, 2014, Connect filed its second Motion for Summary Judgment.
7. On May 22, 2014, DigitalMojo filed, and the Board denied, a Motion to Compel discovery responses necessary to respond to Connect’s April 29, 2014, Motion for Summary Judgment. While Connect’s Motion for Summary Judgment has been before the Board, these cases have been suspended.
8. On February 27, 2015, the Board decided Connect’s April 29, 2014, second Motion for Summary Judgment, granting Connect partial summary judgment based on the services identified in Connect’s international class 35 registration.

B. DigitalMojo’s Discovery in This Case

1. On January 10, 2011, DigitalMojo served on Connect Public Relations, Inc.<sup>1</sup>:
  - a. APPLICANT’S INTERROGATORIES, SET ONE.
  - b. APPLICANT’S REQUEST FOR REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS, SET ONE.
  - c. APPLICANT’S REQUEST FOR ADMISSIONS, SET ONE.

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<sup>1</sup> At the time of first serving discovery, and up until the time DigitalMojo filed its Petitions to Cancel two of Connect’s registrations on August 22, 2011, DigitalMojo was merely “Applicant” in these now consolidated actions, while Connect was merely “Opposer.”

2. On February 14, 2011, Connect, in response to DigitalMojo's January 10, 2011, discovery requests, served on DigitalMojo:
  - a. OPPOSER'S RESPONSES TO APPLICANT'S FIRST SET OF INTERROGATORIES.
  - b. OPPOSER'S RESPONSES TO APPLICANT'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS.
  - c. RESPONSES TO APPLICANT'S FIRST SET OF REQUESTS FOR ADMISSIONS.

DigitalMojo attaches to this Motion, as Exhibit A, copies of Opposer's responses to interrogatories and its responses to requests for admissions as served on DigitalMojo February 14, 2011.

3. On February 24, 2011, DigitalMojo served on Connect:
  - a. APPLICANT'S INTERROGATORIES, SET TWO.
  - b. APPLICANT'S REQUEST FOR REQUEST FOR PRODUCTION OF DOCUMENTS AND THINGS, SET TWO.

4. On September 4, 2011, DigitalMojo served on Connect:
  - a. APPLICANT'S INTERROGATORIES, SET THREE.
  - b. APPLICANT'S REQUEST FOR ADMISSIONS, SET TWO.

5. On December 5, 2011, Connect, in response to DigitalMojo's September 4, 2011, discovery requests, served on DigitalMojo:
  - a. OPPOSER'S RESPONSES TO APPLICANT'S THIRD SET OF INTERROGATORIES.
  - b. RESPONSES TO APPLICANT'S SECOND SET OF REQUESTS FOR ADMISSIONS.

DigitalMojo attaches to this Motion, as Exhibit B, copies of Opposer's responses to interrogatories and its responses to requests for admissions as served on DigitalMojo December 5, 2011.

6. On March 12, 2014, DigitalMojo served on Connect:
  - a. PETITIONER'S INTERROGATORIES, SET ONE.And on March 13, 2014, DigitalMojo served on Connect:

- b. PETITIONER’S INTERROGATORIES, SET TWO.
  - c. PETITIONER’S REQUESTS FOR ADMISSIONS, SET ONE.
  - d. PETITIONER’S REQUESTS FOR ADMISSIONS, SET TWO.
- 7. Consistent with the order of the Board dated August 14, 2013, discovery in these consolidated actions closed on March 13, 2014.
- 8. On April 21, 2014, Connect, in response to DigitalMojo’s March 12, 2014, discovery requests, served on DigitalMojo:
  - a. RESPONDENT’S RESPONSES TO PETITIONER’S INTERROGATORIES, SETS ONE AND TWO.
  - b. RESPONDENT’S RESPONSES TO PETITIONER’S REQUESTS FOR ADMISSIONS, SETS ONE AND TWO.

DigitalMojo attaches to this Motion, as Exhibit C, copies of Opposer’s response to interrogatories and its responses to requests for admissions as served on DigitalMojo April 21, 2014.

- 9. On May 5, 2014, counsel for DigitalMojo contacted counsel for Connect by email and by regular post outlining DigitalMojo’s objections to Connect’s April 21, 2014, responses to DigitalMojo’s March 12, 2014, discovery requests, and requesting full and complete supplemental responses thereto. DigitalMojo attaches to this Motion, as Exhibit D, a copy of DigitalMojo’s request to “meet and confer,” dated May 3, 2014, about discovery issues, along with Digitalmojo’s email of May 3, 2014.
- 10. On May 13, 2014, on the date set by counsel for Connect and counsel for DigitalMojo, counsel for Connect contacted counsel for DigitalMojo by email and by regular post outlining Connect’s position on DigitalMojo’s discovery objections. DigitalMojo attaches to this Motion, as Exhibit E, a copy of Connect’s May 13, 2014, letter. On that same day, Connect agreed to supplement its responses to RESPONDENT’S RESPONSES TO PETITIONER’S REQUESTS FOR ADMISSIONS, SETS ONE AND TWO. Two days later, on May 15, counsel for Connect refused to provide supplemental responses to the

remainder of DigitalMojo's requests for admissions, and also refused to provide any supplemental responses to RESPONDENT'S RESPONSES TO PETITIONER'S INTERROGATORIES, SETS ONE AND TWO. Given the position set forth by Connect in its letter of May 13, 2014 (Exhibit E), DigitalMojo has not pressed the issue of Connect's discovery responses while Connect's Motion for Summary Judgment remained pending.

11. On March 3, 2015, DigitalMojo again contacted Connect by email to request Connect's responses to DigitalMojo's discovery (or suspension of these cases while Connect considers DigitalMojo's most recent settlement proposal), and to advise Connect's attorney that Connect's discovery responses (or such suspension) was necessary. DigitalMojo attaches to this Motion, as Exhibit F, a copy of its email of March 3, 2015, referring to copies of its letter dated May 13, 2014 (attached to Exhibit F), and CPR's letter dated May 13, 2014 (Exhibit E).
12. On March 4, 2015, Connect's counsel responded by email advising it would discuss the settlement proposal with its client, but has not responded to DigitalMojo's email of March 3, 2015, regarding discovery. Under the circumstances, DigitalMojo believes this Motion to Compel is necessary to secure responses to its reasonable discovery requests.

**C. CONNECT'S RESPONSES TO DIGITALMOJO'S INTERROGATORIES, SETS ONE AND TWO**

In Connect's responses to DigitalMojo's Interrogatories, Sets One and Two, Connect responded with two objections to DigitalMojo's discovery requests:

1. "Petitioner's Interrogatories Set One and Set Two exceed the limitation of 75 interrogatories set in the November 17, 2010, letter [between Petitioner and Respondent], because Petitioner has already previously served 75 interrogatories in the parent-opposition proceeding," and
2. "[T]he current interrogatories as captioned above, are directed to issues germane to the parent-opposition proceeding and not the child-cancellation proceedings, namely, Cancellation Nos. 92054395 and 92054427," and "Petitioner cannot use its interrogatories permitted in the cancellation proceedings to inquire into matters

germane solely to the parent-opposition proceeding and having no relevance whatsoever to the cancellation proceedings.”

Connect bases the first of these objections on the letter dated November 17, 2010 between counsel, in which the parties agreed to 75 interrogatories for the parent proceeding, namely, Opposition No. 91196299. Connect goes on to (correctly) say “Petitioner has previously served 75 interrogatories in the parent-opposition proceeding, “thus meeting the number of allowed interrogatories for that proceeding.” Connect has provided no rationale for the second objection.

The Board Order dated August 14, 2013 set forth the following discovery schedule:

*Discovery opens in cancellation proceedings and*

*reopens in opposition proceeding: September 14, 2013*

*Initial disclosures in cancellation proceedings due: October 14, 2013*

*Expert disclosures in all proceedings due: February 11, 2014*

*Discovery closes: March 13, 2014*

DigitalMojo takes from this schedule that its is entitled to propound discovery from September 14, 2013, until March 13, 2014. Since Connect has not alleged DigitalMojo’s discovery requests fall outside this date range, DigitalMojo believes Connect is required to respond to DigitalMojo’s discovery served March 12, 2014.

As to the November 17, 2010, agreement regarding discovery in the parent-opposition, this agreement was reached before DigitalMojo filed and consolidated DigitalMojo’s petitions to cancel into this opposition. Connect and DigitalMojo have no agreement about the number of interrogatories “the parties” may propound in the cancellation proceedings after they were consolidated, and DigitalMojo asserts consolidating these three actions does not eliminate its right to undertake further discovery, even beyond that agreed on November 17, 2010, and the Board discovery schedule implies DigitalMojo has just such a right.

Moreover, “a proceeding with multiple marks and/or a counterclaim may involve unusually numerous or complex issues, and these are factors that will be considered in determining a motion for leave to serve additional interrogatories.” TBMP 405.03(c). The filing and consolidation of DigitalMojo’s petitions to cancel into this opposition raises just such a “unusually numerous or complex issues” requiring additional interrogatories. A decision on the merits in these consolidated cases requires full and complete responses from Connect.

Further, DigitalMojo thinks Connect is not acting in good faith as it objects to all of



DigitalMojo's interrogatories by merely refusing to respond on the day agreed to exchange responses, and in its "responses." As Connect's attorney, counsel for Connect should have called counsel for DigitalMojo to voice objections to discovery requests long before these discovery responses were due (especially in light of the recent agreement to exchange discovery responses on the same day). Equity in these consolidated cases requires full and complete responses from Connect.

**D. RESPONDENT'S RESPONSES TO PETITIONER'S REQUESTS FOR ADMISSIONS, SETS ONE AND TWO**

As to Connect's responses to DigitalMojo's requests for admissions, Connect has responded to those requests with, essentially, two kinds of statements:

1. First, Connect has responded to requests for admissions numbers one (1) through four hundred three (403) with:

"Opposer objects to this request to the extent that it has been previously asked and answered."

The requests for which this response is supplied have been asked, but they have not been answered. Instead, DigitalMojo has received in the past responses which claim these requests are "irrelevant" or "vague," or for some other reason should not be, or cannot be, answered. Thus, in some responses in the past, Connect has responded with:

"Opposer objects to this request as irrelevant and therefore denies the same. The definiteness of the services listed in Opposer's registrations is not at issue in this opposition proceeding."

DigitalMojo first notes that the first of Connect's objections to DigitalMojo's requests for admissions is an objection to the extent requests for admissions 1 through 403 have been both asked and answered. Of course, a proper response ("answer") to a request for admission is (or includes) at least an admission or a denial, and Connect's objections on this basis extend by their terms to its responses which contain admissions or denials. However, many of Connect's responses to DigitalMojo's requests for admissions 1 through 403 neither admit nor deny. As to these requests for admissions, Connect has not in fact objected, because an objection to the extent a request has been asked and answered cannot extend to responses which have not been answered (admitted or denied). DigitalMojo believes it is entitled to admissions or denials.

DigitalMojo also notes that, while "relevancy" is a basis upon which Connect may

object, relevancy is not a basis upon which Connect may refuse to answer, and Connect's registrations are, in fact, now at issue in this opposition proceeding.

As to whether DigitalMojo's questions are "vague," DigitalMojo has provided guidance when responding to DigitalMojo's discovery, wherever Connect has (as it has in most places) objected on this basis to words or phrases placed in quotes. DigitalMojo has advised Connect that such words or phrases are in quotes because they are words used by Connect, either in its marketing materials, or as the words Connect has used to identify its services in the registrations upon which it is basing its opposition. DigitalMojo has also suggested Connect may use any dictionary of its choosing to determine the meaning of these words, and respond with full and complete answers with those meanings in mind.

2. Second, Connect has responded to requests for admissions number four hundred thirty-nine (439) through four hundred forty-two (442) with:

"Opposer objects to this request as seeking information not relevant to the subject matter of this proceeding and not calculated to lead to the discovery of admissible evidence."

DigitalMojo again notes that "relevancy" is a basis upon which Connect may object, but it is not a basis upon which Connect may refuse to answer. As to whether these questions are "not calculated to lead to the discovery of admissible evidence," DigitalMojo disagrees with Connect's unsupported conclusion on this question.

Connect is obligated to respond to discovery and, as responding party, it is Connect's burden to justify its objections or failure to provide a complete answer. Further, to avoid the conclusion that Connect's response is evasive, Connect may reasonably qualify its response to enable an answer. However, Connect has not "reasonably qualified" its lack of answers in these cases. A decision on the merits in these consolidated cases requires full and complete responses from Connect.

Connect is not acting in good faith as it objects and fails to fully respond to DigitalMojo's requests for admissions, for the first time, in its "responses." As Connect's attorney, counsel for Connect should have called counsel for DigitalMojo to voice Connect's view on this discovery long before these discovery responses were due, given the recent agreement to exchange discovery responses on the same day.

Equity in these consolidated cases requires full and complete responses from Connect.

## CONCLUSION

Whereupon Applicant and Petitioner in these consolidated cases (“DigitalMojo”), hereby requests leave to serve (or re-serve) on Connect Public Relations, Inc., Opposer and Respondent in these consolidated cases (“Connect”), the following discovery requests:

- a. PETITIONER’S INTERROGATORIES, SET ONE.
- b. PETITIONER’S INTERROGATORIES, SET TWO.
- c. PETITIONER’S REQUESTS FOR ADMISSIONS, SET ONE.
- d. PETITIONER’S REQUESTS FOR ADMISSIONS, SET TWO.

DigitalMojo also requests the Board order Connect to provide full and complete supplemental responses to these discovery requests, as served on Connect on March 12 and March 13, 2014.

DigitalMojo further requests the Board suspend these proceedings, while it considers this motion, and reset the discovery and trial schedule in these consolidated proceedings as necessary to allow service of these discovery requests (if necessary) by DigitalMojo, and responses to these requests by Connect.

Date: March 11, 2015




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Thomas W. Cook, Reg. No. 38,849

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this document is today being submitted via electronic filing utilizing the ESTTA system on:

Date: March 12, 2015

  
Kay Horne

CERTIFICATE OF SERVICE

This is to certify that on this date, a true copy of the foregoing

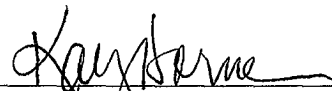
**MOTION TO COMPEL SUPPLEMENTAL RESPONSES TO:**

- 1. PETITIONER'S INTERROGATORIES, SET ONE AND SET TWO, AND**
  - 2. PETITIONER'S REQUESTS FOR ADMISSIONS, SETS ONE AND TWO**
- NECESSARY FOR RESPONSE TO OPPOSER'S MOTION FOR SUMMARY JUDGEMENT Fed. R. Civ. P. 56(f) AND FOR LEAVE TO SERVE ADDITIONAL DISCOVERY**

is being served, by U.S. mail, postage prepaid, addressed to the following:

Karl R. Cannon  
CLAYTON, HOWARTH & CANNON, P.C.  
P.O. Box 1909  
Sandy, Utah 84091-1909

Date: March 12, 2015

  
Kay Horne